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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,210	09/10/2001	Trevor Wright	36-1473	2424
23117 7590 02/24/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER CHAI, LONGBIT				
ART UNIT		PAPER NUMBER		
2431				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/936,210

**Applicant(s)**

WRIGHT ET AL.

**Examiner**

LONGBIT CHAI

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/30/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Presently, pending claims are 1 – 10 and 16 – 20.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/30/2009 has been entered.

#### ***Specification***

3. The amendment of the specification filed on 2 May 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure at this stage of prosecution. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure, at the time when the invention was made, is as follows: "As is also well known a URL typically includes a file name. Of course a "domain name" part of the URL will also be present and must be resolved to identify the computer to which a request is directed. As those in the art also well appreciate, a file name may take the form of a path name". This is because, Examiner notes, there are quite a number of URLs that are *typically* not necessarily constituted of a file name / path name in the field. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter such as “the received request includes a pathname for the requested file” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention – please refer to the section of objection for the specification as set forth above.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 5 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claim(s) recite(s) a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claim(s) is/are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The recited method claim(s) including steps of validating and retrieving is (are) broad enough that the claim(s) could be completely performed mentally, verbally or without being tied to a machine nor is any

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transformation apparent. Any other claims not addressed are rejected by virtue of their dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 10 and 16 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bisbee et al. (U.S. Patent 6,237,096).

As per claim 1, 4, 5, 7 and 9, Bisbee teaches a server computer comprising:

**a store arranged to store one or more computer files** (Bisbee: Abstract and Column 7 Line 22 – 34);

**a store arranged to store at least one digital signature** (Bisbee: Abstract and Column 7 Line 22 – 34).

**each computer file having an associated digital signature using a singing key**  
(Bisbee: Abstract, Column 7 Line 22 – 34 and Column 2 Line 18 – 21);

**a receiver arranged to receive a request from at least one other computer for access to a least one computer file stored on said server computer** (Bisbee: Abstract / Last sentence and Column 1 Line 15 – 16).

**means arranged to retrieve said at least one requested computer file** (Bisbee: Abstract / Last sentence and Column 1 Line 15 – 16);

**means arranged to retrieve the digital signature or signatures associated with said at least one requested computer file** (Bisbee: Abstract, Column 11 Line 35 – 42 and Column 3 Line 11 – 13: by verifying such as signature itself, the integrity of the document and expiry time period of the signature);

**means arranged to validate the digital signature or signatures associated with said at least one requested computer file** (Bisbee: Abstract, Column 11 Line 35 – 42, Column 3 Line 11 – 13, Column 7 Line 29 – 33 and Column 11 Line 28 – 29: *an authentication check at a server* by verifying such as signature itself, the integrity of the document and expiry time period of the signature); and

**means arranged to deny said other computer access to said at least one requested computer file if the digital signature or signatures associated with each respective requested computer file is invalid** (Bisbee: Column 15 Line 10 – 12, Column 11 Line 35 – 42, Column 3 Line 11 – 13, and Column 1 Line 15 – 16 and Column 7 Line 29 – 33: only validated / authenticated documents (i.e. not a document having an unauthorized replacement / alteration) are retrieved by the server upon verifying such as signature itself, the integrity of the document and expiry time period of the signature).

As per claim 2, Bisbee teaches a store arranged to store a list of approved computer file signing parties; each computer file signing party having at least one associated signing key with which to create digital signatures; and in which said means arranged to validate the digital signature associated with each requested computer file invalidates said digital signature if said digital signature was created with a signing key not associated with an approved computer file signing party (Bisbee: Abstract and Column 2 Line 18 – 21).

As per claim 3, Bisbee teaches said means arranged to validate the digital signature associated with said at least one requested computer file invalidates said digital signature if the current clock date is later than the expiry date associated with the or each computer file (Bisbee: Column 3 Line 11 – 13 and Column 7 Line 45 – 47: time / date of expiry).

As per claim 6, Bisbee teaches medium embodying computer readable: Code for loading into a computer and executable by said computer to perform the method according to claim 5 (Bisbee: Figure 2 and Column 4 Line 52 – 65).

As per claim 8 and 10, Bisbee teaches at least one digital signature associated at the server computer with a stored file has been created from the file by the server computer using a signing key (Bisbee: Column 2 Line 18 – 21 and Column 11 Line 40 – 42).

As per claim 16 – 20, Bisbee teaches the received request includes a pathname for the requested file (Bisbee: Column 1 Line 26 – 29 / Line 34 – 39 and Abstract / Last sentence: unlike the paper-based communication, electronic communications with *on-line* document retrieval capability assures the identity of the document is sufficient to identify the path where the original document is *electronically* stored /archived at the server).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

Longbit Chai E.E. Ph.D  
Primary Examiner, Art Unit 2431  
02/17/2009